

09 SEP 2005 #5



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Klauber & Jackson
411 Hackensack Ave., 4th Fl.
Hackensack, NJ 07061

In re Application of : DECISION ON
ARUMOA :
Application No.: 10/509,209 :
PCT No.: PCT/US2003/009840 : PETITION
Int. Filing Date: 28 March 2003 :
Priority Date: 28 March 2002 : UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 1362-1-020PCTUS :
For: NEUROPROTECTANT METHODS, :
COMPOSITIONS AND SCREENING METHODS :
THEREOF :
:

This is in response to the petition under 37 CFR 1.47(b), filed 01 July 2005, to permit the applicant to file the above-captioned application on behalf of the assignee and on behalf of the non-signing inventor Okezie I. Aruoma. The petition under 37 CFR 1.47(b) is DISMISSED as moot. The \$130.00 petition fee has been made paid.

BACKGROUND

On 28 March 2003, applicant filed international application PCT/US2003/009840, which claimed priority of an earlier US application filed 28 March 2002. A Demand for international preliminary examination, in which the United States was elected, was filed on 27 October 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 September 2004.

On 24 September 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); and a unexecuted declaration.

On 29 March 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating an oath or declaration and the surcharge for submitting the oath or declaration later than 30 months was required. The Notification set a two-month period for reply.

On 01 July 2005 applicant filed the present petition under 37 CFR 1.147(b) requesting acceptance of the application without the signature of the applicant. The fee and a request for a

one-month extension of time accompanied the petition. The petition was deposited with a certificate of mailing under 37 CFR 1.8 indicating the paper was filed on 29 June 2005.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant's petition has satisfied items (1) and (6) above.

Regarding item (2) above, applicant has concluded that Mr. Aruoma has refused to sign the declaration. In the present instance, a copy of a letter from Ms. Hathaway to Mr. Aruoma has been presented. The letter indicates that a copy of the application papers and declaration were sent via FEDEX to Mr. Aruoma for signature. Despite applicant statement there is no evidence that Mr. Aruoma received the package. Additionally, there is not a statement from Ms. Hathaway attesting to her actions.

Regarding item (3), it does not appear that applicant has given the last known address of the inventor. The declaration has what appears to be a home address, whereas the petition states that the application was sent to the last known work address. It is not clear that mail sent to applicant employer would reach applicant.

Regarding item (4), applicant has not submitted a declaration by the 37 CFR 1.47(b) applicant in compliance with 37 CFR 1.497 nor the \$130.00 surcharge for submitting an oath or declaration later than 30 months from the priority date.

Regarding item (5), applicant has not demonstrated that applicant has a propriety interest in the invention. While applicant has presented "consultancy" agreements between Mr. Aruoma and OXIS Health Products, Inc., applicant has not presented any evidence to corroborate the claim that Mr. Aruoma made the invention while he was working under the agreement. Further more, the agreement dated 19 June 2000, appears to be missing the attachments referred to in the document. Additionally, this agreement does not appear to require Mr. Aruoma relinquish any patent rights to his inventions. When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement

to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

CONCLUSION

The petition under 37 CFR 1.47(b) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration

LES:ls

Telephone: (571) 272-3297
Facsimile: (571) 273-0459